

REMARKS

Prior to the continued examination of the above-referenced application, Applicant requests the above amendment be entered. Claims 1, 3 and 5-11 were pending in the application. In this Supplemental Amendment, claims 1 and 8-10 was amended. Claims 1, 3 and 5-11 thus remain for consideration.

Applicant respectfully submits that all of the claims now pending in the application are in condition for allowance, which action is earnestly solicited.

§ 112 Rejection

In an Interview conducted with Examiner Madsen on October 6, 2005, Examiner Madsen stated that claim 1 would be rejected under 35 U.S.C. 112, first paragraph.

Applicant has amended claim 1 as suggested by Examiner. Accordingly, Applicant respectfully traverses this rejection.

§ 103 Rejection

In an Office Action dated March 15, 2004, Claims 1, 3 and 5-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lagarde et al. (US Patent Number 4,690,967) in view of Llorente Hompanera (US Patent Number 6,197,359) and White et al. (US Patent Number 3,310,521) and Phipps et al. (US Patent Number 6,063,894) and Osaka Titanium Co. (JP Patent Number 73,014,145). In an interview with Examiner on October 6, 2005, Examiner maintained these rejections.

Applicant submits that independent claim 1 is patentable over Lagarde, Llorente Hompanera, White, Phipps, and Osaka Titanium Co on the basis that (1) there is no suggestion or motivation in any of the references to combine these references, (2) Examiner used improper hindsight when combining these references, (3) the references teach away from the combination of these references and, finally, (4) the White, Phipps and Osaka references are non-analogous art.

Claim 1 of Applicant's invention recites,

"A process for producing a silicone mould useful for baking a food product comprising the steps of:

preparing a flexible and foldable mould, said mould being formed essentially from 100 weight parts of a heat curable silicone elastomer material and cross-linking said silicone elastomer in the presence of about 0.5 to 2.0 weight parts of peroxide;

baking said mould at an elevated temperature for a period of time sufficient to obtain a flexible and foldable mould product;

rinsing said baked mould with boiling water for a period of time sufficient to remove the odor of the peroxide therefrom; and,

cleaning said rinsed mould by exposing it to ultrasonic treatment."

During the October 6th interview and in the March 15th Office Action, Examiner maintained his § 103 rejection. However, upon Applicant's further review, Applicant believes that Examiner has unsuccessfully used LaGarde and Llorente as prior art references and has failed to overcome their deficiencies.

To establish a prima facie case of obviousness, Examiner has to show that there is some suggestion or motivation, either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP § 2143. LaGarde and Llorente are the only proper analogous art references used by Examiner. However these references, either alone or in combination, do not suggest or motivate Applicant's invention.

Examiner relies on LaGarde disclosing a process for producing a silicone mould to be in contact with foodstuff. Examiner alleges that the mould in LaGarde is formed essentially from 100 weight parts of a heat curable silicone elastomer material and cross-linking said silicone elastomer in the presence of about 0.5 to 2.0 weight parts of peroxide. And after formation, the mould is heated to remove volatiles. However, Examiner admits that LaGarde does not teach "rinsing said baked mould with boiling water for a period of time sufficient to remove the odor of the peroxide therefrom; and, cleaning said rinsed mould by exposing it to ultrasonic treatment."

To overcome the deficiencies of LaGarde, Examiner relies upon Llorente teaching a process of baking a mould at an elevated temperature for a period of time sufficient to obtain a flexible and foldable mould product and steaming said baked mould for a period of time sufficient to remove volatiles. However, Llorente teaches only steam to purify the mold; it does not teach boiling water as claimed in Applicant's claim 1.

Since LaGarde and Llorente are the only "facts of record pertaining to the level of skill in the art," and neither of them teaches, suggests or motivates Applicant's invention, it can be logically concluded that there is no suggestion in the knowledge generally available in the food preparation industry to modify the above references to include purification with water and ultrasound. MPEP § 2144.08 II A 3.

Based on the above analysis, it can be logically concluded that Examiner did not establish the prima facie case of obviousness and should withdraw his §103 rejection.

Examiner, however, incorrectly argues that the deficiencies of LaGarde and Llorente could be overcome by White, Phipps and Osaka. These latter references cannot be used because they are nonanalogous prior art. MPEP § 2141.01(a) requires Examiner to use analogous prior art to support any 35 U.S.C. § 103 rejection. A reference is analogous art if it is either in the field of applicant's endeavor or, if not, it is reasonably pertinent to the particular problem with which the inventor was concerned."

MPEP § 2141.01(a).

In our case, Examiner should have used references in the field of applicant's endeavor, i.e. the food preparation field. However, Examiner failed to do so and used three nonanalogous prior art references: White and Phipps from the dentistry field, and Osaka from the electrical engineering field. These references are not only in fields different from the one of the inventor's endeavor, but are also not reasonably pertinent to the inventor's concern. The main concerns of these references are: (1) in White - to obtain a pure polymer maintaining its characteristics and avoiding dental machinery damage; (2) in Phipps - to provide flexible and comfortable mouthpieces, and (3) in Osaka - to increase the yield of pure semiconductors having enhanced conductive properties. In contrast, the main concern in Applicant's case is to provide baking receptacles clean enough to be safe for human use, which is clearly different from those in White, Phipps and Osaka. Therefore, White, Phipps and Osaka are non-analogous art references and Examiner cannot use them to support his § 103 rejection.

Also, White, Phipps and Osaka are nonanalogous art under the established principles of the U.S. District Court for the Federal Circuit, which requires that Examiner look at “the similarities and the differences in the structure and function of the inventions” as carrying “far greater weight.” MPEP § 2141.01(a) (citing to *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA, 1973)).

In re Clay, claims were directed to a process for storing a refined liquid hydrocarbon product in a storage tank having a dead volume between the tank bottom and its outlet port wherein a gelled solution filled the tank’s dead volume to prevent loss of stored product while preventing contamination. MPEP § 2141.01(a) (citing *In re Clay*, 966 F.2d 656, 23 USPQ 2d 1058 (Fed. Cir. 1992)). In this case, the reference relied upon disclosed a process for reducing the permeability of natural underground hydrocarbon bearing formations using a gel similar to that of applicant to improve oil production. The court disagreed with the PTO’s argument that the reference and claimed inventions were part of the same endeavor “maximizing withdrawal of petroleum stored in petroleum reserves,” and found that the inventions involved different fields of endeavor since the reference taught the use of the gel in a different structure for a different purpose. *Id.*

Similarly to the facts in *Clay*, where the application and reference had different structures (storage tanks versus extracting devices) and different purposes (storing hydrocarbons versus extracting hydrocarbons), in our case the application and the references have different structures (baking receptacles versus dental polymers, mouth pieces and semiconductors), and different purposes (cleaning baking receptacles to make them suitable for human use versus purifying dental polymers to avoid compromising their properties and dental machinery, curing silicone mouth pieces making them more

flexible and comfortable, and increasing the yield of pure semiconductors with enhanced selective conductivity).

In addition, the subjects of the application and reference in *Clay* are part of the same petroleum industry, whereas the subjects of our application and the references are parts of entirely different industries, i.e. the food preparation industry versus the dental and electrical engineering industries. These differences further supports Applicant's contention that White, Phipps and Osaka are nonanalogous prior art.

The court in *Clay*, found that the reference was not reasonably pertinent to the problem with which the inventor was concerned because a person having ordinary skill in the art would not reasonably have expected to solve the dead volume in tanks for refined petroleum by considering a reference dealing with plugging underground formation anomalies. Similarly, in our case, the references are not reasonably pertinent to the problem with which inventor is concerned since a person skilled in the food preparation industry would not reasonably have expected to solve the problem of cleaning baking receptacles to make them suitable for human use by considering references dealing with dental polymers purification, silicone mouth pieces curing and semiconductors conductivity enhancement. Thus, the above references are nonanalogous art under the Federal Circuit's construction and Examiner should withdraw his § 103 rejection.

Furthermore, Examiner's use of nonanalogous art references from unrelated industries will discourage future inventors from applying for patents and disclosing their inventions. This will undermine the seminal policy of the U.S. patent system, which is to put the public in intellectual possession of valuable inventions so that it can (1) benefit

from the invention after the patent had expired, (2) improve on the invention, and (3) design around the claims.

Even if we ignore the fact that White, Phipps and Osaka are nonanalogous art, Examiner still cannot use these references because they do not “suggest or motivate” one skilled in the food preparation industry to purify baking mould with water and ultrasound. MPEP §2143.

Examiner, however, argues that the deficiencies of LaGarde and Llorente can be overcome by combining White, Phipps and Osaka.

Firstly, Examiner relies upon White as evidence that silicone rubbers may be purified in boiling water. However, White only teaches using boiling water to cure a silicon mouth piece making it more flexible and comfortable, and to sterilize the mouth piece by removing any potentially harmful bacteria. It is important to note that White’s mouthpieces are cleaned with boiling water only after impressions were made by biting into the silicon, i.e. after being in contact with the oral cavity. This clearly indicates that the main purpose of the boiling water is to cure the silicone rubber providing a flexible, irritation free mouth piece, and not purifying it to remove volatilities and harmful substances. This is different from Applicant’s purpose of purifying the baking receptacles as set forth in the FDA’s guidelines for silicone products in contact with foodstuffs.

Therefore, White neither suggests nor motivates one skilled in the food preparation industry to combine its teaching with the ones in LaGarde and Llorente and clean Applicant’s products with boiling water. The only way that Examiner could combine these references is to use improper hindsight.

Under MPEP § 2145.X.A., Examiner has “to take into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant’s disclosure.” Otherwise, Examiner is using “impermissible hindsight.” *Id.* LaGarde and Llorente are the closest analogous art references and neither of them teaches or suggests Applicant’s invention. Additionally, at the time of Applicant’s invention nobody in the food preparation industry was using boiling water and ultrasound to remove volatilities and harmful substances. Therefore, Examiner uses impermissible hindsight in combining White, LaGarde and Llorente.

Secondly, Examiner further improperly relies on Phipps to avoid the deficiencies of White. Phipps teaches a step of removing undesired impurities from oriented dental polymers using ultrasonification. The oriented polymers are not used in products for cooking food. Despite the use of ultrasound, Phipps teaches away from using boiling water as costly, time consuming, and deteriorating the polymers’ characteristics. Since White teaches away from Applicant’s invention, Examiner cannot use it in a combination with other references. MPEP § 2145.X.D.2.

Finally, to overcome the deficiency in Phipps Examiner improperly uses Osaka teaching silicon semiconductor purification using organic solvent and ultrasound, and water (for organic solvent removal) and ultrasound. Examiner uses improper hindsight to rely on Osaka. Osaka uses water mainly to remove the organic solvent, and neither suggests nor motivates one skilled in the food preparation industry to use water and ultrasound in purifying baking receptacles and making them safe for human use.

Therefore, Examiner's belief that when LaGarde, Llorente, White, Phipps and Osaka are combined the present invention is obvious is not accurate. LaGarde and Llorente are the only analogous art references properly used but they do not teach, suggest or motivate Applicant's invention. Furthermore, the deficiencies of LaGarde and Llorente cannot be overcome by the nonanalogous art references White, Phipps and Osaka. Phipps teaches away from Applicant's invention and cannot be combined with White and Osaka, which are not sufficient to support the § 103 rejection. Furthermore, these references, alone or in combination, does not suggest or motivate Applicant's invention. Accordingly, Applicant believes that Claim 1 of the present invention is patentable over the cited references.

Claims 3 and 5-11 depend on claim 1. Since claim 1 is believed to be patentable over Lagarde, Llorente, White, Phipps, and Osaka Titanium Co., claims 3 and 5-11 are believed to be patentable over Lagarde, Llorente, White, Phipps, and Osaka on the basis of their dependency on claim 1.

Applicant respectfully submits that all of the claims now pending in the application are in condition for allowance, which action is earnestly solicited.

CONCLUSION

Based on the above remarks and arguments, Applicant believes that Claims 1, 3 and 5-11 are patentable over the cited references. Applicant has amended claim 1 according to Examiner's suggestion to overcome the § 112 rejection. In addition, Applicant has shown that Examiner improperly cited references to support the § 103 rejection. Thus, Examiner should withdraw his § 112 and § 103 rejections and allow Applicant's claims.

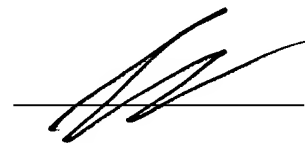
If any issues remain, or if Examiner has any further suggestions, he/she is invited to call the undersigned at the telephone number provided below.

Examiner is hereby authorized to charge any insufficient fees or credit any overpayment associated with the above-identified application to Deposit Account No. 06-0515.

Respectfully submitted,

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